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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,485	05/29/2002	Lars Andresen	P 290643	3220

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EXAMINER

TAYLOR, BARRY W

ART UNIT	PAPER NUMBER
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2643

DATE MAILED: 01/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/069,485

Applicant(s)

ANDRESEN ET AL.

Examiner

Barry W. Taylor

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>12/13/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1. Claims 1-3, 7, 11-12 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henderson et al (6,404,869 hereinafter Henderson) in view of Martin et al (5,909,485 hereinafter Martin) further in view of Senn et al (6,704,563 hereinafter Senn).

Regarding claim 1. Henderson teaches a method for customizing a prepaid service (abstract, figure 1) in a telecommunications system, the method comprising:

maintaining subscriber information on at least one prepaid subscriber (see 106 figure 1 used to store subscriber information for subscribers);

defining at least two different prepaid profiles, each prepaid profile defining at least one attribute for the prepaid service (see 106 figure 1 used to define profiles such as card usage data having attributes of remaining minutes, unit billing rates (col. 5 lines 16-53), other profiles include location identifier(s) corresponding to geographic locations, telephone numbers having attributes of special, preferred, and discount telephone service rates (col. 5 lines 16-53);

associating the subscriber's subscriber information with one of the at least two different profiles (col. 5 lines 54-64), and

providing the prepaid service to the subscriber as indicated by the attribute defined in the one prepaid profile associated with the subscriber (col. 5 lines 41-47).

Martin also teaches a method of prepaying for consumption of telephone calls (title, abstract) wherein at least three payment options are provided (col. 5 line 1 – col. 8 line 64) thereby giving user more options to select from when making telephone calls from any phone (col. 11 lines 13-15).

According to Applicants newly amended claim language Henderson in view of Marin fail to show subscription information associated with the prepaid account (see Applicants newly amended claims and brief comments, paper dated 10/17/05).

Senn also teaches a system and method associated with prepayment accounts (title, abstract) in conjunction with coupon (col. 2 lines 19-24). Senn also teaches subscription information associated with prepaid profiles (col. 3 line 63 – col. 4 line 8,

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col. 5 lines 49-56, col. 6 line 14 – col. 8 line 45) allowing for different service rates to be employed. Senn provides for many variations as well. For example, Senn allows for rates to be reevaluated when user travels to different service areas (see prepayment plan A item 150A in figure 1 and prepayment plan B item 150B in figure 1) or when the distance between the user and recipient become shorter (i.e. shorter distances resulting in a decreased connection rate, col. 8 line 63 – col. 9 line 25, col. 11 lines 20-41).

It would have been obvious for any one of ordinary skill in the art at the time of invention to utilize the teachings of Senn into the teachings of Henderson in view of Martin in order to provide for a more flexible prepaid service that automatically selects payment options and rate plans.

Regarding claim 2. Henderson discloses carrying out associating during subscription provisioning (col. 5 lines 16-21).

Regarding claim 3. Henderson discloses updating subscriber information during recharge (col. 6 lines 14-23).

Regarding claim 7. Henderson teaches a telecommunications system offering prepaid subscription services (see 104 figure 1), the system comprising at least one database (see 106 figure 1) having subscriber information on at least one prepaid subscriber, wherein the system is arranged to maintain at least two different profiles, each profile defining at least one attribute for the prepaid service (see 106 figure 1 used to define profiles such as card usage data having attributes of remaining minutes, unit billing rates (col. 5 lines 16-53), other profiles include location identifier(s) corresponding to geographic locations, telephone numbers having attributes of special, preferred, and

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discount telephone service rates (col. 5 lines 16-53); to associate the subscriber's subscriber information with one profile (col. 5 lines 54-64); and to provide the prepaid service to the subscriber as indicated by the attribute defined in the profile associated with the subscriber (col. 5 lines 41-47).

Martin also teaches a method of prepaying for consumption of telephone calls (title, abstract) wherein at least three payment options are provided (col. 5 line 1 – col. 8 line 64) thereby giving user more options to select from when making telephone calls from any phone (col. 11 lines 13-15).

According to Applicants newly amended claim language Henderson in view of Marin fail to show subscription information associated with the prepaid account (see Applicants newly amended claims and brief comments, paper dated 10/17/05).

Senn also teaches a system and method associated with prepayment accounts (title, abstract) in conjunction with coupon (col. 2 lines 19-24). Senn also teaches subscription information associated with prepaid profiles (col. 3 line 63 – col. 4 line 8, col. 5 lines 49-56, col. 6 line 14 – col. 8 line 45) allowing for different service rates to be employed. Senn provides for many variations as well. For example, Senn allows for rates to be reevaluated when user travels to different service areas (see prepayment plan A item 150A in figure 1 and prepayment plan B item 150B in figure 1) or when the distance between the user and recipient become shorter (i.e. shorter distances resulting in a decreased connection rate, col. 8 line 63 – col. 9 line 25, col. 11 lines 20-41).

It would have been obvious for any one of ordinary skill in the art at the time of invention to utilize the teachings of Senn into the teachings of Henderson in view of

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Martin in order to provide for a more flexible prepaid service that automatically selects payment options and rate plans.

Regarding claims 11-12. Henderson teaches a network element (see 104 figure 1) in a telecommunication where subscribers of the system can prepay for their calls (col. 6 line 19) using prepaid card (120 figure 1) inherently reading on voucher, the element including a database (see 106 figure 1) or a connection (col. 5 lines 1-16) to a database having subscriber information of prepaid subscribers, wherein the network element is arranged to have access to profile definitions, each profile defining at least one attribute for the prepaid service (see 106 figure 1 used to define profiles such as card usage data having attributes of remaining minutes, unit billing rates (col. 5 lines 16-53), other profiles include location identifier(s) corresponding to geographic locations, telephone numbers having attributes of special, preferred, and discount telephone service rates (col. 5 lines 16-53)), and to update the subscriber information during recharge according to a profile associated with the recharging subscriber's subscriber information (col. 6 line 19).

Martin also teaches a method of prepaying for consumption of telephone calls (title, abstract) wherein at least three payment options are provided (col. 5 line 1 – col. 8 line 64) thereby giving user more options to select from when making telephone calls from any phone (col. 11 lines 13-15).

According to Applicants newly amended claim language Henderson in view of Marin fail to show subscription information associated with the prepaid account (see Applicants newly amended claims and brief comments, paper dated 10/17/05).

Senn also teaches a system and method associated with prepayment accounts (title, abstract) in conjunction with coupon (col. 2 lines 19-24). Senn also teaches subscription information associated with prepaid profiles (col. 3 line 63 – col. 4 line 8, col. 5 lines 49-56, col. 6 line 14 – col. 8 line 45) allowing for different service rates to be employed. Senn provides for many variations as well. For example, Senn allows for rates to be reevaluated when user travels to different service areas (see prepayment plan A item 150A in figure 1 and prepayment plan B item 150B in figure 1) or when the distance between the user and recipient become shorter (i.e. shorter distances resulting in a decreased connection rate, col. 8 line 63 – col. 9 line 25, col. 11 lines 20-41).

It would have been obvious for any one of ordinary skill in the art at the time of invention to utilize the teachings of Senn into the teachings of Henderson in view of Martin in order to provide for a more flexible prepaid service that automatically selects payment options and rate plans.

Regarding claim 16. Henderson teaches defining profiles before accessing telecommunication system (col. 5 lines 16-21). Martin also teaches the user first presented with option to select which payment option to use (title, abstract, col. 5 line 1 – col. 8 line 64, col. 5 line 16-21).

2. Claims 4-6, 8-10 and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henderson et al (6,404,869 hereinafter Henderson) in view of Martin et al (5,909,485 hereinafter Martin) and Senn et al (6,704,563 hereinafter Senn) further in view of Pierce et al (5,408,519 hereinafter Pierce).

Regarding claims 4, 8 and 13. Henderson does not explicitly show the attribute of being a deposit function defining how to calculate the credit during recharge.

Pierce teaches telecommunications system and method for recharging account balance. Pierce allows the user to arrange for automatic renewal of the account balance on a regular basis, for example, a user may arrange to have the \$25.00 face value of a debit account restored automatically a maximum of one time every seven days if and when the account balance falls below \$5.00 (col. 4 lines 24-65 and col. 6 lines 8-17) and if the debit account has already been restored during that seven-day period, the system will not restore the balance a second time as a protection against fraud (col. 4 lines 66-68).

It would have been obvious for any one of ordinary skill in the art at the time of invention to modify the pre-paid telephone calling card processing system (see 104 figure 1) to incorporate the renewal function as taught by Pierce for the benefit of automatically renewing the balance of pre-paid account on a regular basis.

Regarding claims 5, 9 and 14. Henderson does not explicitly show the attribute of being an expiry function defining how to calculate the validity time of the prepaid account.

Pierce teaches telecommunications system and method for recharging account balance. Pierce allows the user to arrange for automatic renewal of the account balance on a regular basis, for example, a user may arrange to have the \$25.00 face value of a debit account restored automatically a maximum of one time every seven days if and when the account balance falls below \$5.00 (col. 4 lines 24-65 and col. 6

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lines 8-17) and if the debit account has already been restored during that seven-day period, the system will not restore the balance a second time as a protection against fraud (col. 4 lines 66-68).

It would have been obvious for any one of ordinary skill in the art at the time of invention to modify the pre-paid telephone calling card processing system (see 104 figure 1) to incorporate the renewal function as taught by Pierce for the benefit of limiting the number of times the pre-paid account can be replenished during a week.

Regarding claims 6, 10 and 15. Henderson does not explicitly show the attribute of being an expiry state handling function defining how the possibilities of a subscriber are limited over time when no recharge is carried out.

Pierce teaches telecommunications system and method for recharging account balance. Pierce allows the user to arrange for automatic renewal of the account balance on a regular basis, for example, a user may arrange to have the \$25.00 face value of a debit account restored automatically a maximum of one time every seven days if and when the account balance falls below \$5.00 (col. 4 lines 24-65 and col. 6 lines 8-17) and if the debit account has already been restored during that seven-day period, the system will not restore the balance a second time as a protection against fraud (col. 4 lines 66-68).

It would have been obvious for any one of ordinary skill in the art at the time of invention to modify the pre-paid telephone calling card processing system (see 104 figure 1) to incorporate the renewal function as taught by Pierce for the benefit of

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automatically renewing the balance of pre-paid account if and when the account balance falls below certain value.

Response to Arguments

3. Applicant's arguments with respect to claims 1-11 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion


4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barry W. Taylor, telephone number (571) 272-7509, who is available Monday-Friday, 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz, can be reached at (571) 272-7499. The central facsimile phone number for this group is **571-273-8300**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group 2600 receptionist whose telephone number is (571) 272-2600, the 2600 Customer Service telephone number is (571) 272-2600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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BARRY TAYLOR
PRIMARY EXAMINER